

REMARKS

In the Office Action, the Examiner rejected pending claims 1-59. By this paper, Applicants amended claims 1, 5-16, 19, 22, 25, 27-34, 36, 40, 43, 44, 47-50, 52-53, and 56-58, and cancelled claims 4, 26, 51, 55 and 59. No new matter has been added. In view of the foregoing amendments and the following remarks, the Applicants respectfully request reconsideration and allowance of all pending claims.

Claim Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-59 under 35 U.S.C. § 103(a) as being unpatentable over Eder (US Patent 6,321,205, hereinafter "Eder") in view of Javitt (US Patent No. 5,918,208, hereinafter "Javitt"). Applicants respectfully traverse this rejection. Specifically, the Examiner stated:

Eder discloses a method for providing a financial outlook (see col. 5, lines 1-10), the method comprising: providing an electronic form having fields for entering financial data of facility associated with at least one of a plurality of modalities (see fig. 13, element 806, also see col. 18, lines 12-20), the financial data comprising projected changes in at least a portion of the financial data over a future analysis period (see abstract, also see col. 6, lines 45-50); electronically receiving the financial data from the electronic form via a network (see col. 9, lines 50 – col. 10, line 24); routing the financial data into a financial analysis system (i.e., Neural networks consist of a number of processing elements (hereinafter, referred to as nodes) that send data to one another via connections, see col. 24, lines 44-50, also see col. 10, lines 5-10, i.e., determine which data need to be extracted and transferred from the database server via the interconnection network to the application server computer....); generating a pro forma financial report for the future analysis period tailored to the financial data (see col. 13, lines 49-62); and electronically transmitting the pro forma financial report to a client via the network (col. 8, lines 15-21, also see col. 7, lines 10-13, and col. 46 line 61 – col. 47, line 8). Eder does not expressly disclose a method for providing a financial outlook for a medical facility. However, Javitt makes this disclosure (see abstract, also see col. 1, lines 5-15). Thus it would have been obvious to one of ordinary skill in the art to combine Eder with Javitt to enable medical care professionals to use a broad array of assumptions to forecast utilization of medical procedures and estimated revenue per procedure under multiple capitation scenarios and to provide for a more comprehensive and efficient system

for financial/management analysis of medical business operations. Further, medical facility is simply an intended subject use of this invention, and the functions described in hereinabove can be applied to any facility or business operation, services or products; with the names of their specific industry and related products and services simply replacing "medical facility" and its related products and services by name.

Office Action, pages 2-3.

Legal Precedent

First, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). To establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Moreover, a statement that the proposed modification would have been "well within the ordinary skill of the art" based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to modify* the teachings of the reference. See *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

Second, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959); *see* M.P.E.P. § 2143.01. Similarly, if a proposed modification renders the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. M.P.E.P. § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Lastly, it is improper to combine references when the combination requires substantial reconstruction or redesign of the main reference to arrive at the claimed invention. *In re Ratti*, 123 U.S.P.Q. at 349.

Features of Independent Claim 1 Missing From the Cited Combination

Claim 1 recites “providing an electronic form having fields for selecting a desired medical imaging system”, and “system operational data for the desired medical imaging system.” In contrast, the Eder and Javitt references taken alone or together fail to teach or suggest an electronic form for selecting a medical imaging system, nor do they teach system operational data for the medical imaging system. Eder discloses *general non-medical* user inputs which define data fields used by software. *See* col. 18, lines 12-20. The software taught by the Eder reference is directed towards extracting, aggregating and storing transaction data associated with *intangible* assets. *See*, Eder, col. 8, lines 1-10; col. 5, lines 12-15. Hence, the forms taught by Eder are incapable of accommodating system operational data of a medical imaging system. For example, system operational data include a variety of operational data determined by the medical imaging system’s specification, such as operational and maintenance cost, patient throughput, availability, etc. These parameters are specific to a medical imaging system and cannot be covered by the forms provided by Eder. Similarly, Javitt fails to disclose forms for system operational data for a medical imaging system. The Javitt reference teaches a computer

system accepting user input for enabling a physician to forecast utilization of medical procedures (not system operational data). Javitt, col.1, lines 44-57. For at least these reasons, the Eder and Javitt references, taken alone or in hypothetical combination, fail to teach or suggest the foregoing features of claim 1.

Further, claim 1 recites “analyzing a desired purchasing option...to obtain the desired medical imaging system”, based on the financial data of the client “to provide a client-specific financial analysis of the desired purchasing option.” In contrast, the Eder reference discloses generic purchasing subsystems, wherein “[t]hese systems incorporate worksheets, files, tables and databases...[that] contain information about the company operations and its related accounting transactions.” See, e.g., Eder, col. 12, lines 57-60; see also table 6. Thus, the systems disclosed by the Eder reference are not specifically tailored for analyzing a purchase of a system, much less a medical imaging system. Further, the Javitt reference does not teach or suggest any analysis directed to purchasing a medical imaging system, or a client-specific financial analysis of a desired purchasing option. The Javitt reference provides a system that enables health care professionals to estimate revenue per procedure under multiple capitation scenarios. See, Javitt, Abstract. Accordingly, Applicants submit that the Eder and Javitt references, taken alone or in hypothetical combination, fail to teach or suggest the foregoing features of claim 1. For these reasons as well, independent claim 1 and its dependent claims are believed to be allowable over the cited combination.

Features of Independent Claim 19 Missing From the Cited Combination

Claim 19 recites an interface, “wherein the interface includes fields for selecting a desired medical imaging system from a plurality of medical imaging systems”. Claim 19 further recites a system configured to generate a projected financial report tailored to client data “wherein the projected financial report enables a client to evaluate feasibility of purchasing the desired medical imaging systems.” In stark contrast, Eder and Javitt are absolutely devoid of an interface configured to accommodate selecting a desired medical

imaging system from a plurality of medical imaging systems. Similarly, Eder and Javitt are devoid of a financial report tailored to such systems. See, generally, Eder, col. 12, lines 32-67; Figures 1-9C; and Javitt col. 3, lines 8-54; Figure 3. The cited references clearly fail to disclose techniques for evaluating client data associated with a medical imaging system. The Eder and Javitt systems are incompatible with specific financial data (e.g., variable and fixed costs, revenues, deductions, etc.) of *medical* imaging systems. The types of *interfaces* and *financial reports* recited in claim 19 are clearly structured or configured for *evaluating client data of a medical imaging system*, and are not a simple representation of applying the generic business accounting techniques disclosed in Eder and Javitt to a medical imaging system. Rather, the claimed *interface* and *financial report* denotes types of interfaces and financial reports that are different than any interface or report described in the Eder or the Javit reference. Accordingly, for at least these reasons, independent claim 19 and its dependent claims are believed to be allowable over the cited combination.

Features of Independent Claim 34 Missing From the Cited Combination

Claim 34 recites “providing an interface having a form for selecting a desired medical imaging system from a plurality of medical imaging systems” and a form for “entering *client data* relating to the healthcare facility including system operational data of the desired medical imaging system.” Conversely, the Eder and Javitt references, taken alone or in hypothetical combination, do not teach or suggest a *form* for entering of client data related to a healthcare facility and/or a medical imaging system. Instead, as discussed above, Eder provides for forms to extract, aggregate and store transaction data associated with *intangible* assets (not system operational data). Eder, col. 8, lines 1-10; col. 5, lines 12-15. The Javitt reference fails to obviate the deficiencies of the Eder reference. The Javitt reference teaches a method for accepting user input for enabling a physician to forecast utilization of medical *procedures*, and clearly has nothing to do with a form for entering *client data* relating to the healthcare facility or a medical imaging system. Javitt, col.1, lines 44-57. For at least this reason, the Eder and Javitt references,

taken alone or in hypothetical combination, fail to teach or suggest the foregoing features of claim 34.

Independent claim 34 further recites “returning a pro forma financial report to a client via the network to enable the client to evaluate feasibility of a possible transaction to obtain the desired medical imaging system.” The Eder system displays financial forecasts projecting a firm’s growth based on option pricing and cash flow analysis. Eder col. 6, lines 25-64. As stated above, the Javitt reference provides financial analysis of revenue due to expected medical procedures under capitation scenarios. Javitt, col. 3, lines 29-54. Eder and Javitt simply do not disclose returning a pro forma financial report, much less a pro forma financial report to enable a client to evaluate feasibility of a transaction to obtain a medical imaging system. Therefore, for at least these reasons, independent claim 34 and its dependent claims are believed to be allowable over the Eder and Javitt references.

Features of Independent Claim 43 Missing From the Cited Combination

Claim 43 recites “an Internet query form having a plurality of data entry fields configured for accepting financial data of a medical diagnostic system”, wherein the entry fields include “a medical operational time field associated with efficiency of the desired medical diagnostic system for a potential purchase transaction.” Claim 43 further recites “a revenue field associated with the medical diagnostic system.” In contrast, Eder and Javitt do not teach or suggest an internet query form having data entry fields accepting financial data of a medical diagnostic system. Furthermore, Eder and Javitt clearly do not disclose a system for financially analyzing a potential purchase transaction of a desired medical diagnostic system. Thus, Eder and Javitt, taken alone or in hypothetical combination, can not teach the related Internet results page. Again, Eder instead provides a financial forecast based on option pricing and cash flow analysis. Eder col. 6, lines 25-64. Javitt discloses a “computer system which accepts user input relating to contract variables ...performs a utilization and revenue analysis for both commercial and

Medicare-age beneficiaries.” Javitt, col. 1, lines 45-50. Further, the teachings of Javitt are tailored for producing synthetic fee schedules for comparing revenue and costs for services under reimbursement scenarios. Javitt, col. 1, lines 50-56. No disclosure in Javitt acknowledges or suggests a financial outlook for a purchase transaction of a medical diagnostic system, as recited in claim 43. For at least these reasons, independent claim 43 and its dependent claims are believed to be allowable over the hypothetical combination of Eder and Javitt.

Features of dependent Claim 53 Missing From the Cited Combination

Claim 53 is directly dependent from claim 1. The claim recites “medical resource options include a magnetic resonance imaging (MRI) system, a computed tomography (CT) system, an ultrasound system, or any combination thereof.” Again, Applicants respectfully submit the modalities recited in the above claim are not disclosed or suggested by the Eder and Javit references. More critically, the forms provided by these references are not suitable for providing fields to accept financial data including system operational data of imaging systems, such as MRI, CT, ultrasound or any combination thereof. For at least these reasons, independent claim 53 is believed to be allowable over the hypothetical combination of Eder and Javitt.

Request Withdrawal of Rejection

For these reasons, the Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103.

Improper Combination - Lack of Objective Evidence of Reasons to Combine

In addition, the Examiner has not shown the requisite motivation or suggestion to modify or combine the cited references to reach the present claims. As summarized above, the Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). In the present

rejection, the Examiner combined the cited references based on the *conclusory and subjective statement*, stating that “Thus it would have been obvious to one of ordinary skill in the art to combine Eder with Javitt to enable medical care professionals to use a broad array of assumptions to forecast utilization of medical procedures and estimated revenue per procedure under multiple capitation scenarios and to provide for a more comprehensive and efficient system for financial/management analysis of medical business operations.” *See* Office Action, page 3. Accordingly, Applicants challenge the Examiner to produce *objective evidence* of the requisite motivation or suggestion to combine the cited references, or remove the foregoing rejection under 35 U.S.C. § 103.

Conclusion


The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Authorization for Extensions of Time and Payment of Fees

In accordance with 37 C.F.R. § 1.136, Applicants hereby provide a general authorization to treat this and any future reply requiring an extension of time as incorporating a request thereof. The Commissioner is authorized to charge any fees which may be required, to the Deposit Account No. 07-0845; Order No. GEMS:0122/YOD (15-EC-5773).

Respectfully submitted,

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